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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,473	11/28/2003	Andrew F. Knight	009	7986
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ANDREW F. KNIGHT			COBURN, CORBETT B	
20 Carolina Avenue			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/722,473	KNIGHT, ANDREW F.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0/24/07, 5/17/07</u>                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Preliminary Discussion***

1. Applicant seeks a patent on a method of relating a story having certain plot elements. Applicant seeks a patent not only for tangible recordings (i.e., printed material and video) of any story with these plot elements, but for any story containing these elements in whatever form. Thus if someone described the plot of a movie that was made using the claimed storyline, he would be infringing any patent issued. Furthermore, Applicant is claiming intellectual property rights in any and all stories that follow the plotline claimed. This is a significant change to the scope of the existing intellectual property scheme that would have staggering impact upon many industries and many facets of our daily lives.
2. It is not often that the Office is asked to create an entirely new form of intellectual property. It therefore behooves the Examiner to do an analysis of the patent law as it might apply to this case starting from first principles.

### **Pre-constitutional Protection of Intellectual Property**

3. In 1624, the English Parliament passed the Statute of Monopolies which granted inventors the sole right to their invention for fourteen years. In 1710, the English Parliament passed the Statute of Anne creating the world's first copyright laws. Thus prior to the American Revolution, America had a bifurcated system of intellectual property. Intellectual property that was protected by one set of statutes was not protected by the other. The drafters of the U.S. Constitution carried on this separation.

### **The Constitution**

4. Article I, Section 8 of the Constitution of the United States gives the Congress the authority, “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

5. It is significant that the framers recognized two separate classes of people who should receive intellectual property rights – *viz.* authors and inventors. Furthermore, the framers were careful to separate writings and discoveries. A basic principle of statutory interpretation is that courts should “give effect, if possible, to every clause and word of a statute, avoiding, if it may be, any construction which implies that the legislature was ignorant of the meaning of the language it employed.” *Montclair v. Ramsdell*, 107 U.S. 147, 152 (1883). Thus we must interpret the separation of these terms as an indication that the framers intended to treat authors and their writings separately from inventors and their discoveries.

6. This conclusion is bolstered by the fact that, upon the adoption of the Constitution, the Congress created two separate forms of intellectual property – copyrights (under the Copyright Act of 1790) and patents (under the Patent Act of 1790) to protect the rights of authors and inventors respectively. This is not surprising given the bifurcated system that was in existence prior to independence. Throughout the entire history of the republic, Congress has maintained this dichotomy.

7. Over the last 218 years, Congress has changed the patent and copyright laws many times. Congress has had ample opportunity to provide for patent protection for storylines, but has not done so. It is not the function of the Office to create new forms of intellectual property of such a

sweeping nature. This is especially true since the effect of such a form of patent would be completely contrary to the intent of the patent law.

8. It should also be pointed out that storylines are not subject to improvement. Storylines may be changed, but not improved. Adding a plot element involving a white rabbit in a top hat would not improve *Huckleberry Finn*; it would merely make it different. Nothing in a storyline patent application can be used by other practitioners to advance the storytelling art. Thus storyline patents would not carry out the constitutionally mandated purpose behind the patent laws – i.e., to promote the progress of science and the useful arts.

9. More importantly, such a class of intellectual property would actually have the effect of discouraging the progress of science and the useful arts.

10. Under current law, if a potential author reads a *Narrative of the Most Extraordinary and Distressing Shipwreck of the Whale-Ship Essex* and thinks he can do a better job telling the story, he may make an attempt. Thus the public gets two versions of the story from which to choose – Owen Chase's or Herman Melville's. But under the proposed scheme, it is unlikely that the public would have either version. Instead of writing the great American novel, existence of a storyline patent would create an incentive for potential authors to write the great American patent application. This is hardly the result that the framers of the Constitution had in mind.

11. Writing a book or script can be difficult and time consuming. Books often have hundreds of pages. Applicant's specification contains 18 pages, of which less than nine actually involve descriptions of the storyline. Clearly, it is easier to write a patent application for a storyline than to write a novel or script based on the storyline. If it were possible to patent storylines, it would

soon become evident that it was more profitable to write patent applications than it would be to write actual stories.

12. Consider the effect of the proposed storyline patents on motion picture writers. If a movie discovers that a patent application exists that might cover a storyline for a movie that is about to be released, he will have an incentive to license that potential patent. Such a license would be cheaper than patent litigation and certainly less time consuming. This is true even if the producer or publisher believes the patent will not issue. After spending tens of millions of dollars to produce a movie, a studio simply cannot afford to risk an injunction. Therefore there would be an incentive for would-be writers to flood the Office with applications for storyline patents in hopes that some author is out there actually doing the work of creating a story from which the applicant could profit.<sup>1</sup>

13. While the effect on the motion picture industry's bottom line would be lamentable, this need not concern us. But we must concern ourselves with the effect of the proposed storyline patents on literary creation. We must ask ourselves if granting storyline patents would result in the creation of more literary works or fewer. Undoubtedly, the effect would be that fewer literary works would be created. If Chase had been able to patent his storyline, we would not have had *Moby Dick*.

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<sup>1</sup> Some people are critical of the patent system because there are people who have patents for invention they have no intention of making or using. Examiner will not join in this debate, but will make two observations:

- (1) To the extent that this represents a problem, it would be unwise to add to the problem by creating yet another class of intellectual property to be held by those who are not going to make or use their invention.
- (2) In defense of the holders of patents for inventions currently patentable, they at least provide an increase in human knowledge upon which others can improve. If A. Lincoln invents a device for lifting boats over shoals, others can improve upon the invention – whether Lincoln builds such a device or not. Thus science and technology advance. Storyline patents, on the other hand, are not amenable to "improvement".

14. People of little or no literary skill would be able to patent storylines. These people are unlikely to create literary works under the current scheme and even more unlikely to do so if they have a storyline patent. (If a patentee wrote a story based on his patent & it was not successful, this might lower the value of the patent.) Thus the public would not only be denied Melville's *Moby Dick*, but more than likely would also be denied Chase's *Narrative of the Most Extraordinary and Distressing Shipwreck of the Whale-Ship Essex*.

15. Some may argue that storyline patents would foster the "invention" of storylines. But storylines are not technology and cannot be "invented" in the sense intended by the Framers. Furthermore the Constitution and the laws of the United States already provide intellectual property protection for storylines – i.e., copyrights. Congress has weighed the interests of all parties to the intellectual property bargain and has determined that there should be a bifurcated system of intellectual property laws with the patent laws protecting technology and copyright laws protecting expression.

16. In the case of copyrighted material, Congress has also had to weigh the interests of creators of intellectual property with society's interest in freedom of expression. This issue is the gravest constitutional issue associated with the proposed storyline patent. The First Amendment states in pertinent part, "Congress shall make no law ... abridging the freedom of speech, or of the press..." As the Court has ruled, "Any system of prior restraints of expression comes to this Court bearing a heavy presumption against its constitutional validity." *Bantam Books v. Sullivan*, 372 U.S. 58, 70 (1963). Government "thus carries a heavy burden of showing justification for the imposition of such a restraint." *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 419 (1971); *New York Times Co. v. United States*, 403 U.S. 713, 714 (1971).

17. The proposed storyline patent would certainly involve a system of prior restraint of expression -- no story involving a patented storyline could be conveyed in **any** form. Nor would there be any reasonable justification for this drastic abridgement of freedom of speech.<sup>2</sup> Therefore, storyline patents cannot pass constitutional muster. It is a well settled principle of statutory construction that statutes will not be interpreted to reach unconstitutional results.

*United States v. Jin Fuey Moy*, 241 U.S. 394, 401 (1916); *Almendarez-Torres v. United States*, 523 U.S. 224, 237-38 (1998); *Jones v. United States*, 529 U.S. 848, 857 (2000). This being the case, the patent laws cannot be interpreted as allowing the Office to issue storyline patents.

18. In summary, the United States has always maintained a separation between those intellectual property rights that have been available to writers and those that have been available to inventors. There is nothing in the history of the patent law to suggest that storylines should be considered “inventions” to be protected by the patent law. Doing so would arguably contradict the purpose of the nation’s intellectual property laws by inhibiting progress in the sciences and the useful arts. Moreover, and perhaps more importantly, a storyline patent would be a prior constraint on free speech that is prohibited by the First Amendment. For these reasons, a storyline cannot be considered to be statutory subject matter under 35 U.S.C. §101.

#### ***Claim Rejections - 35 USC § 101***

19. 35 U.S.C. 101 reads as follows:

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<sup>2</sup> Nor can it be argued that the proposed storyline patents encompass merely commercial speech that is entitled to less protection than other forms of speech. Imagine a storyline patent containing the plot to *Fahrenheit 9/11*. The existence of this patent would have precluded **any** discussion of the issues raised by the movie in any form whatsoever. The fact that *Fahrenheit 9/11* was a motion picture released for profit does not change the fact that it was primarily an exercise in political speech. Whether we agree or disagree with the views expressed is immaterial. A patent that prevented Mr. Moore from expressing these views would be an unwarranted abridgement of freedom of speech and would be prohibited by the 1<sup>st</sup> Amendment.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

21. 35 U.S.C. §101 authorizes the grant of a patent for “anything under the sun made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) at 310. This being said, the courts have found exceptions to this rule. Some things are not patentable because they are not made by man – e.g., minerals found in the earth, laws of nature. Some things are not patentable because they are not “made” – e.g., abstract ideas, mathematical algorithms. Some things may not be patentable because of constitutional considerations – e.g., human beings are not patentable probably because the 13<sup>th</sup> Amendment prohibits anyone owning a property right in a human being.<sup>3</sup> In all likelihood, some things would not be patentable due to public policy considerations – e.g., no one would suggest that a patent issue for a method of committing terrorist acts. Applicant’s claimed invention falls into several of these categories.

22. As noted above, 35 U.S.C. §101 cannot be interpreted as allowing storyline patents for constitutional reasons. Furthermore, a storyline is not a “process, machine, manufacture or composition of matter.” A storyline *per se* is an abstract idea. As the Court noted in *Diamond v. Diehr and Lutton*, 209 USPQ 1 (U.S. 1981), an abstract idea is not patentable. Nor can a storyline be transformed into a patentable process merely by reciting it as a process of telling a

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<sup>3</sup> The MPEP states, "If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter." Not rationale is given and as far as Examiner is aware, no court has ruled on the issue. However, many commentators have suggested that the 13<sup>th</sup> Amendment's prohibition of slavery provides the rationale for this policy.

story. “To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection.” *Id.* at 10.

23. Therefore, we must determine whether the claimed invention is a practical application of the judicial exception to statutory subject matter for abstract ideas.

24. The instant application is in many ways analogous to that considered by the Court in *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972). In that case, the Court considered whether a program to convert binary coded decimals to pure binary was patentable. The Court ruled, “It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting binary code to pure binary were patented in this case. The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is *affirmed*, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.” (Emphasis in original.)

25. In the instance case, the effect of granting a patent would be to wholly preempt the use of the storyline or plot (which is analogous to a mathematical formula), thus patenting every practical application of the idea. As the Court ruled in *Benson*, this is tantamount to patenting the idea itself. Thus claims 1-6 & 16 clearly must be rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter (i.e., an idea).

26. Since the remaining claims specify a format for use in expressing the story, Applicant may contend that *Benson*’s reasoning does not apply to these claims. This argument would not be persuasive. The Court in *Benson* determined that a claim that precluded all uses of an idea in a particular environment (i.e., in digital computers) was non-statutory. It should be noted that

Benson's claim was considered non-statutory even though it made changes to physical objects (i.e., wrote data to various registers in a computer). Thus claims that preclude all uses of an idea in a particular medium would be a patent on that idea. Thus claims 7-15 & 17-20 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter (i.e., an idea).

27. Another test for statutory subject matter was developed by the court in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). To apply this test, we must determine whether the claimed invention produces a "useful, concrete and tangible result". *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. According to the Office's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (hereinafter, "Interim Guidelines"), "a 35 U.S.C. § 101 judicial exception is claimed ... if the claimed invention otherwise produces a useful, concrete, and tangible result."

28. Analysis of the claimed process shows that it does not produce a concrete result. The "Interim Guidelines" make it clear that in order to be considered concrete, the process must "substantially produce the same results". A process that produces unpredictable results cannot be considered to be concrete.

29. Yet one cannot predict the results of Applicant's process – a dozen different storytellers can use the same plot to tell a dozen different stories. Suetonius tells the story of Julius Caesar's assassination. Shakespeare takes the same plot elements and tells an entirely different story. Nor can one reading Suetonius predict what Shakespeare's story will be. Applicant's claims

suffer from the same deficiency. Since Applicant's process cannot produce predictable results, it does not produce concrete results. Therefore the claimed subject matter is non-statutory.

30. In addition, the claimed subject matter constitutes non-functional descriptive material that does not exhibit any functional relationship to the substrate upon which it is recorded or to the computer that reads or outputs the story either as part of the stored data or as part of the computing processes performed by the computer. Non-functional descriptive material is non-statutory.

31. A mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwin*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter se-forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate, which they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is no-statutory subject matter.

32. For the reasons outlined above, Claims 1-20 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

***General Discussion of Obviousness Relating to Storyline Patents***

35. It has been suggested that the claimed storyline is rendered obvious by a combination of *Rip Van Winkle*, stories about hypnosis, and/or the movie *Vanilla Sky* (Manevitz, 24 Cardozo Arts & Ent. L.J. 717). Examiner disagrees. Since there is no technological basis for evaluating combinations of plot elements, it would be impossible to apply the *Graham v. John Deere Co.* analysis to storylines.

36. First of all, it is impossible to determine “the state of the art”—i.e., the scope and content of the prior art. Even if the Examiner had the tools and the time to search the world’s literature, storytelling is not an “art”<sup>4</sup> in the sense that we use it in the patent law. As discussed above, one

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<sup>4</sup> This discussion has the potential to be confusing. Storytelling is an art (in the sense that painting is an art), but not an “art” in the patent law sense. In the patent law, “art” is a term of art that means roughly, “technology”. In an

cannot build on “prior discoveries” in the storyteller’s art. Therefore, the art of storytelling has no “state”. In a technology, one can trace the evolution of the technology over time. Once can ascertain when certain elements are added to the technology. This is not possible with storytelling.

37. Since searching the world’s literature for plot elements would be impossible (and Examiner uses this word advisedly), it would be impossible to determine the differences between prior storylines and the claims at issue. As a practical matter, the Office simply cannot make the necessary determinations.

38. Since storytelling is not a technology, it is impossible to determine the level of ordinary skill. In fact, the term “level of ordinary skill” has no meaning in this context. Whether someone is a “skillful” story teller is a matter of opinion. Tastes vary. Many believe that James Fenimore Cooper was a skillful storyteller. Many, like Mark Twain<sup>5</sup>, disagree. Since a person’s skill as a storyteller is a matter of opinion and taste, there are no objective criteria for determining the level of “ordinary” skill. And since it is impossible to determine the state of the art, examiner cannot even use the prior art as a reference point.

39. Nor can examiners consider objective evidence indicating obviousness or nonobviousness, for there is none. And there cannot possibly be any such objective evidence. Can anyone produce test data showing an unexpected result? Is there evidence of long felt need? How would that be possible? If there was a long felt need for a particular plot, then the need

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attempt to bring some degree of clarity to the discussion, Examiner will use the word “technology” instead of “art” when used in the patent context.

<sup>5</sup> See “Fenimore Cooper’s Literary Offenses” by Mark Twain.

itself would herald the invention<sup>6</sup>. Are there any suggestions to combine “references”? The only reference that could make such a suggestion would anticipate the storyline.

40. Perhaps we can say that all plot elements are available as prior art & that they can all be combined with a reasonable expectation of success to yield predictable results. That would make all storylines obvious. But there is a presumption that inventions are novel.<sup>7</sup> Adopting such an interpretation would be contrary to the clear intent of Congress and the plain language of the statute.

41. Quite simply put, the Office cannot determine whether a storyline is obvious over the prior art. It is a practical and legal impossibility. “Obviousness” is a meaningless concept when applied to storylines.

42. As a practical matter, it is also impossible to determine if storylines are anticipated by previously existing stories – unless the examiner happens to know the story. People have been telling stories since mankind first used language. They have been writing stories at least since the Sumerians started writing cuneiform tablets. There are no databases that encompass all of the stories told or written by man. Nor could any examiner perform a meaningful search of such a database if one existed. Sumerian scholars are rare in the Patent Office and as anyone who has tried to decipher patent applications translated from modern languages knows, much is lost in translation.

43. Since it is virtually impossible to determine whether a storyline has been used before, we must assume that all storylines meet the requirements of 35 U.S.C. §§102 & 103 —at least with

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<sup>6</sup> Imagine a storyteller who says, “We really need a storyline concerning a girl who follows a white rabbit down a rabbit hole and meets a cat who grins as it disappears, etc.”. By expressing the need for such a plot, the storyteller has “invented” it.

<sup>7</sup> 35 U.S.C. §102 states, “A person shall be entitled to a patent unless...”

respect to novelty on non-obviousness. This does not mean that none of Applicant's claims can be rejected under these sections. The Courts have provided guidance with respect to printed matter.

44. Claims 7-15 & 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over any movie recorded on a DVD.

A movie recorded on a DVD discloses the claimed invention except for the specific arrangement and /or content of indicia (printed matter) set-forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to record a movie with the claimed storyline on a DVD, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPZ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more enjoyable by providing an individual with a specific type of entertainment does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (i.e., the movie having a particular storyline) and the substrate (i.e., the DVD) which is required for patentability.

***Information Disclosure Statement***

45. On 30 July 2007, Applicant filed a number of documents in response to a Request for Information. These documents were not listed on an Information Disclosure Statement. The

PTO-1449 is used by the Publications Branch to determine which references should be cited on the face of a printed patent. Applicant should, therefore, submit a PTO-1449 listing all references submitted in response to the Request for Information.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/  
Primary Examiner  
Art Unit 3714